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10/692,442	10/23/2003	Wayne H. Whittaker	UNS-103-B	8021
7590 Todd L. Moore YOUNG & BASILE, P.C. Suite 624 3001 West Big Beaver Road Troy, MI 48084-3107			EXAMINER GILBERT, WILLIAM V	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/692,442
Filing Date: October 23, 2003
Appellant(s): WHITTAKER ET AL.

Todd Moore
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 January 2010
appealing from the Office action mailed 30 March 2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-3, 7-9 and 17-24 are rejected and subject to appeal.

Claims 1-24 are pending.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim 1-3, 7, 9, 17 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Cristy (U.S. Patent No. 4,074,474).

Claim 1: Cristy discloses an apparatus for isolating and leveling a machine foundation with respect to a substructure comprising a rigid enclosure (Fig. 9) having a substantially hollow upper portion (see "A" from attached Fig. 9, below, the spacers show that it is substantially hollow) telescopically adjustably connected to a substantially hollow lower portion ("B" below) to provide for various sizes of the enclosure;, means for rigidly connecting the upper portion of the enclosure to the lower portion ("C" below) for fixing the position of the upper portion with the lower portion and means for providing leveling adjustment ("D" below; the inflatable portion) of the foundation.

Art Unit: 3635

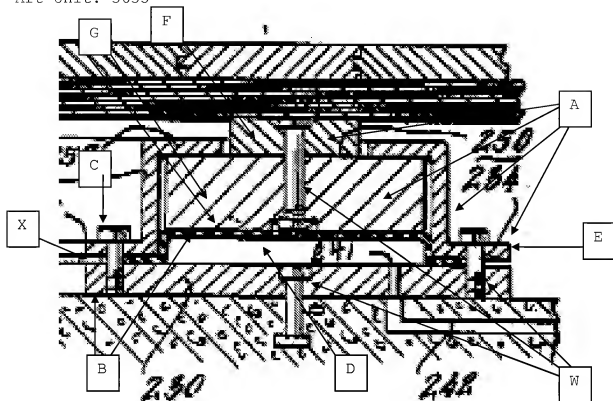


Figure 9 from Cristy

Claim 2: the upper portion has a flange ("E" above) having an aperture extending therethrough (the bolt is in the aperture) and the lower portion has an anchor ring (230; see Fig. 9, generally where it is ring-shaped; see Fig. 5) with at least one rod (the bolt, "C" above) connected thereto and extending through the aperture in the flange above the upper portion, and a slip joint (the connection between the upper and lower sections is a slip joint) connected to the flange of the upper portion for releasably connecting the rod to the flange.

Claim 3: the lower portion has an anchor ring (230; see Fig. 9, generally where as shown this is a ring-shaped device, the upper surface extends into the interior as it is a part of the interior; see also Fig. 5) a bearing member ("F" above) within the enclosure and adjustable connecting to the anchor ring (via the leveling means) to provide a leveling adjustment of the foundation, and a support member ("G" above, including inflatable portion) in contact with the bearing member and engageable with the substructure. The two members "engage" via the lower portion.

Claim 7: the support member is capable of being removed and is between the bearing member and substructure (12) and the support member can be replaced with other support members.

Claim 9: Cristy discloses an apparatus for isolation and leveling comprising a rigid enclosure connectable to the machine foundation having a substantially hollow upper portion ("A" above) and a substantially hollow lower portion ("B" above) telescopically connected to one another, the lower portion having an anchor ring (230) that extends into the interior of the enclosure (the upper surface of the ring extends into the enclosure,) a bearing member ("F" above) disposed within the enclosure above the anchor ring, a plurality of fasteners (see "W" above) that connect the bearing member to the anchor ring in

a vertically spaced relationship (see Fig. 9) for vertical adjustment of the anchor with the bearing member (the members can be loosened or tightened as needed for adjustment,) and a support member ("G" above and leveling means) in contact with the bearing member and engageable with the substructure for isolating the machine foundation from the substructure.

Claim 17: the support member is capable of being removably disposed between the bearing member and substructure and is replaceable.

Claim 21: the upper portion is tubular (it is in the shape of a ring, which is tubular) and having open ends (there is an open end on each side of the bearing member), the lower portion is substantially tubular (it is in the shape of a ring) and having open ends (see "X" above; the joints between the upper and lower portion on each side is an open end.)

Claim 22: Applicant should respectfully note that the limitation "fabricated" is considered product-by-process; therefore, determination of patentability is based on the product itself. See M.P.E.P. §2133. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re*

Thorpe, 777 F.2d 695 (Fid. Cir. 1985). The pieces are integral in that they are attached to each other.

Claim 23: the language "connectable...machine foundation" lines 2-4 is a statement of intended use of the claimed invention and must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The open end at a top surface of the foundation would be proximate the bearing member as shown in Fig. 9 and the second open end at a bottom surface of the foundation would be as proximate "X" above and also 241. The applicant should respectfully note that the "machine foundation" is not positively claimed, so it is not considered, but rather only the capability of the prior art of record to perform the function with a foundation as claimed.

Claim 24: the anchor ring has an inner perimeter (proximate "X") and the fasteners ("C" above) are arrayed around the anchor ring adjacent the inner perimeter.

Claims 8 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cristy.

Claims 8 and 18: the species of Fig. 9 discloses an inflatable portion (232), but not that it is an air bag, as claimed; however, the species of Fig. 6 discloses the use of an inflatable air bag (containing portion 172.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to substitute the inflatable portions because the species are obvious variants of each other and the inflatable element serves the same function in both species and would perform equally as well.

Claim 19: a conduit (242) coupled to and in communication with the inflatable portion (which would be the air bag) and while the particular species in Fig. 9 does not disclose a pressurized air source for communicating pressurized air to and from the bag, the species in Fig. 4 discloses the device (92). It would have been obvious at the time the invention was made to a person having ordinary skill in the art because the inflating system would obviously require a device for inflation and deflation and the apparatus in Fig. 4 would clearly provide such a means for inflation.

Claim 20: a conduit (242) extending through the substructure (12) and into the enclosure where the conduit

communicates with the inflatable portion (which would be the airbag.)

(10) Response to Argument

I. Rejection of claims 1-3, 7, 9, 17 and 21-24 as being anticipated by Cristy:

Claim 1:

The issue is whether the Cristy reference meets the claimed limitation. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference (citing *Verdegaal Bros. v. Union Oil co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). The examiner maintains the Cristy reference properly anticipates the claims and the rejection is proper.

With respect to claim 1, applicant argues that the upper and lower portions as defined by the examiner are not "telescopically adjustably connected" to one another (brief: page 13). The examiner disagrees. In the rejection of claim 1 (see above), the examiner clearly labeled portion "A" of attached Figure 9 from Cristy as the "upper portion" and "B" as the lower portion. The examiner respectfully notes that portion 250 (which is a portion of "A", the upper portion) will adjust

telescopically with respect to portion 230 (which is a portion of "B", the lower portion). The telescopic adjustment occurs with the inflation and deflation of "D" (which is an inflatable portion), which results in the portion of "A" moving telescopically with respect to portion "B". This also meets applicant's provided definition of "telescopic" (brief: page 13). The examiner explained this rationale in the "Response to Arguments" portion of the Office action dated 12 November 2009.

Applicant further argues the incorporation of 35 USC §112, sixth paragraph with respect to the "means for rigidly connecting" and "means for providing a leveling adjustment". The proper test for meeting the definiteness requirement [for 25 USC §112, sixth paragraph] is that the corresponding structure (or material or acts) of a means (or step)-plus-function limitation must be disclosed in the specification itself in a way that one skilled in the art will understand what structure (or material or acts) will perform the recited function (citing *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1381 (Fed. Cir. 1999)). The examiner noted element "C" in attached Figure 9 from Cristy above as the locking means which lock the upper portion ("A" above) and the lower portion ("B" above) together. This meets the limitation as an equivalent under 35 USC §112, sixth paragraph, and thus anticipates the

claim. Regarding the "means for leveling adjustment", applicant notes that the purpose of the leveling adjustment is to adjust the distance between the bearing member and the anchor ring. For reference the examiner noted "F" above as the bearing member (see rejection of claim 3) and the anchor ring as 230 (see rejection of 9). The examiner argues and maintains that portion "D" meets the limitation as an equivalent because it performs the same function in adjusting the distance between the bearing member and anchor ring. As inflation in "D" occurs, the distance between the two members increases, and the distance decreases as "D" deflates. As a result, the limitation meets the requirements under 35 USC §112, sixth paragraph and the rejection is proper.

Claim 2:

Applicant argues that Cristy does not meet the claimed limitation (brief: page 17). The examiner disagrees. The examiner clearly noted the flange ("E" of the upper portion, "A") and the lower portion ("B") has a ring (portion 230 is in the shape of a ring as shown in Figures 5 and 9 of Cristy) and a rod ("C") connecting the two. The claim is anticipated as shown.

Claims 3 and 7:

Applicant provides several arguments with respect to the claims (brief: page 18). First, applicant states portion 230 (defined as a **circular plate**) does not meet the limitation of a ring, and provides a dictionary definition noting that a ring is a "band of any material". The drawings and the examiner's interpretation are clear. As shown in figure 5 and 9 of Cristy, circular plate (230) is a "band of any material" and thus meets the limitation of a "ring". The interpretation of the limitation is proper.

Applicant further argues that the bearing member ("F" as labeled) is not adjustably connected to the anchor ring (brief: page 19). The examiner disagrees. As shown in Figure 9 of Cristy, and explained in the rejection, the leveling means provides the adjustable connection. As the amount of "D" inflates or deflates, element "F" adjusts accordingly with respect to the anchor ring. The interpretation of the limitation is proper.

Applicant last argues that the support member does not engage with the substructure. The examiner disagrees. First the limitation states "engageable with said substructure". This limitation is interpreted as, "Does the support member have the ability to engage with the substructure?" It is not interpreted

that the support member **actually** engages with the substructure. Second, it appears that applicant is equating "engageable" with "contacting", which is a narrow interpretation of the term. USPTO personnel are to give their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In the present case, the support member has the capability of "engaging" the subfloor. In fact, the examiner notes in the rejection that the support member does engage the subfloor via the lower portion (see rejection of claim 3, above). The examiner explained his interpretation of the limitation in the rejection of claim 3 above and maintains the rejection as proper.

Claims 9 and 17:

Applicant provides the same argument with respect to claim 1 regarding the "telescopically adjustably connected" upper and lower enclosures (brief: page 20). The examiner will not repeat

the arguments here for brevity, but maintains the position as noted in the argument above with respect to claim 1.

Applicant additionally argues that element "W", which represent unlabeled bolts, of attached Figure 9 from Cristy does not constitute a "vertical spaced relationship". Please see Figure 9 of Cristy, which shows this limitation is met. As explained in the rejection, the bolts can be loosened and tightened as needed, which meets "adjustable" using the broadest reasonable interpretation in light of applicant's specification. Applicant even notes that the loosening of one of the bolts "W" would deflate the structure, which meets the limitation of "adjustable". The rejection is proper.

Applicant last argues the same limitation of "engageable" as provided in the arguments of claim 3, above. The examiner will not repeat the arguments here for brevity, but maintains the position as noted in the argument above with respect to claim 3.

Claim 21:

Applicant argues that Cristy does not meet the limitation of the claim (brief: page 22). The examiner disagrees. In the rejection of the claim, the examiner stated that both the upper and lower portions are in the shape of a ring (see Figs 5 and 9

of Cristy). A ring, by definition, has a substantially tubular shape and thus meet the claimed limitation. Applicant provides a dictionary definition for "tube" (brief: page 22), and the examiner concludes that the definition is met in that the upper and lower portions are in the shape of a ring, which is a "hollow elongated cylinder" as provided in the definition. As a result, Cristy anticipates the claim.

Claim 22:

Applicant argues that Cristy does not anticipate the claimed limitation because the prior art is not integral. The examiner disagrees. During patent examination, the claims are given the broadest reasonable interpretation consistent with the specification. See *In re Morris*, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim..." (*Superguide Corp. v. DirectTV Enterprises, Inc.*, 358 F.3d 870, 875, 69 USPQ2d 1865, 1968 (Fed. Cir. 2004)). The examiner takes the position that the final product displays an integral structure in that the pieces are attached to each other (as provided in the rejection). The

result is that the parts are integral and Cristy anticipates the claim.

Claim 23:

Applicant argues that the portion defined by applicant does not meet the limitation "open end" (brief: page 24). Applicant again provides functional language to define the claim with the foundation. The examiner defined the open ends in claim 23 as portion "X" (which is a slot) and the portion receiving the bearing member ("F"). Both of these limitations clearly meet the definition of "opening". The applicant has not positively recited a positive connection between the apparatus and machine foundation. Applicant further argues that if the machine foundation were connected in the manner required, it would be inoperable. The examiner is unsure of applicant's position of the argument. Claim 23 requires that "said rigid enclosure [is] connectable to said machine foundation" and first and second open ends are defined. Cristy defines the "open ends" as claimed and thus anticipate the claim.

Claim 24:

Applicant argues that Cristy does not meet the limitation regarding the "inner perimeter" and the "fasteners arrayed

around the anchor ring adjacent the inner perimeter" (brief: page 25). The examiner disagrees. The examiner defined earlier how the member defines a ring (see the arguments regarding claim 3 above), and the examiner clearly noted that portion proximate "X" above denotes an inner perimeter of the ring (see above). The "fasteners" ("C" above) are clearly in an array adjacent the inner perimeter. Portion proximate "X" is **not** an outer periphery, as argued by applicant, but represents an inner periphery (see Figures 5 and 9 of Cristy).

II. Rejection of claims 8 and 18-20 as being obvious over

Cristy:

Claims 8 and 18-20:

Applicant provides no new arguments with respect to the rejection of these claims (brief: pages 26-28). The examiner will not repeat the arguments here for brevity, but maintains the position as noted in the argument above with respect to the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William V Gilbert/

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